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REMARKS

This response is intended as a full and complete response to the final Office Action mailed July 5, 2006. In the Action, the Examiner notes that claims 1-12, 14-33, 35-44, and 46-57 are pending, of which claims 1-12, 14-33, 35-44, and 46-57 stand rejected. All claims continue unamended.

In view of the following discussion, Applicants believe that all of the claims are allowable. It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

REJECTIONS**35 U.S.C. §103****Claims 1-12, 14-33, 35-44 and 46-57**

The Examiner has rejected claims 1-12, 14-33, 35-44 and 46-57 under 35 U.S.C. §103(a) as being unpatentable over Herz U.S. 6,029,195 (hereinafter "Herz") in view of Rooney U.S. 6,819,669 (hereinafter "Rooney"). Applicants respectfully traverse the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Herz and Rooney references alone or in any permissible combination fail to teach or suggest Applicants' invention as a whole.

Applicants' independent claim 1 recites (AND independent claims 17, 22, 35, and 46 recite similar relevant limitations):

1. A method of predicting the behavior of a current user of an interactive television service, comprising the steps of:

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identifying, by a set top box, each activity in which the current user participates while engaged with the interactive television service, and conditions surrounding each such activity;

accessing, by a set top box, a first collection of data that reflects (i) cumulative activities in which other users have participated, (ii) conditions surrounding such other users' cumulative activities, and (iii) patterns of behavior exhibited by such other users through their participation in such cumulative activities, the activities including viewing interactive television programming;

comparing, by a set top box, (i) the current user's identified activities and surrounding conditions and (ii) the other users' cumulative activities and surrounding conditions, to identify similarities therebetween;
and

attributing, by a set top box, to the current user a pattern of future behavior based on such similarities and on the other users' patterns of behavior.

Herz fails to disclose the claimed "comparing, by a set top box, (i) the current user's identified activities and surrounding conditions and (ii) the other users' cumulative activities and surrounding conditions, to identify similarities therebetween".

Herz discloses "a profile processing module which estimates each user's interest in various target objects by reference to the users' target profile interest summaries, for example by comparing the target profiles of these target objects against the search profiles in users' search profile sets" (Herz, col. 7, lines 9-18). Herz defines "target profiles" as "a digitally represented profile indicating that target object's attributes" (Herz, col. 4, lines 49-53). Herz defines a "search profile" for each user, for example the search profile might correspond to a single topic of high interest for the user" (Herz, col. 7, lines 5-9). Thus, Herz teaches that users' interests in objects are estimated by reference to the users' profiles.

By contrast, the claimed invention identifies similarities between the current user's and other users' activities and surrounding conditions in order to predict the current user's behavior. The present invention has two groups of users that are being compared: the current users and other users. Thus, a pattern of future behavior is attributed to the current user based on such similarities and on the other users' patterns of behavior. As stated before, Herz only teaches comparing target profiles against the search profiles. Herz does not compare activities and conditions between the current

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user and other users to attribute future behavior to the current user. Thus, Herz does not teach or suggest "comparing, by a set top box, (i) the current user's identified activities and surrounding conditions and (ii) the other users' cumulative activities and surrounding conditions, to identify similarities therebetween".

The Rooney reference fails to bridge the substantial gap between the Herz reference and Applicants' invention. The Rooney reference discloses a set top box 104 is provided for allowing the user to interact with the program shown on the television set 102. (Rooney, col. 3, lines 64-66.) Rooney also fails to teach or suggest the claimed "comparing, by a set top box, (i) the current user's identified activities and surrounding conditions and (ii) the other users' cumulative activities and surrounding conditions, to identify similarities therebetween".

Because Herz fails to teach or suggest all the elements of claim 1 and Rooney fails to teach or suggest those missing elements, the combination also fails to disclose all the elements of claim 1.

As such, Applicants submit that independent claims 1, 17, 22, 35 and 46 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2-12, 14-16, 18-21, 23-33, 36-44 and 47-57 depend, either directly or indirectly, from independent claims 1, 17, 22, 35 and 46 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicants submit that these dependent claims are also non-obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

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Thus, Applicants respectfully submit that all of the claims are allowable. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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